

REMARKS:

Claims 1-37 are currently pending in the application.

Claims 23 and 37 are currently amended.

Claims 23-33 and 37 are objected to as lacking antecedent basis in the specification.

Claims 1-11, 23-33, 34-35, and 37 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,157,738 to Call (hereinafter “*Call*”).

Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of U.S. Patent No. 7,272,626 to Sahai (hereinafter “*Sahai*”).

Applicant respectfully submits that all of Applicant’s arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

I. Objection to Specification Under 37 C.F.R. 1.75(d)(1)

Claims 23-33 and 37 stand objected to under 37 C.F.R. 1.75(d)(1) as lacking antecedent basis in the immediate specification for “computer-readable” medium. Although Applicant believes that the claims as previously presented contain antecedent basis in the specification, Applicant has amended independent Claims 23 and 37 to recite a “computer-readable storage medium” to further clarify Applicant’s claimed invention.

Further, Applicant respectfully directs the Examiner's attention, for example, to Page 3, Line 5 of the specification of the subject application which provides support for a "computer-implemented system." Applicant respectfully submits that one skilled in the art readily recognizes a "computer-readable storage medium" to be inherent in a "computer-implemented system." Accordingly, Applicant respectfully requests that the objection to Claims 23-33 and 37 under 37 C.F.R. 1.75(d)(1) be withdrawn.

II. Rejection Under 35 U.S.C. § 101

Claims 1-11 and 34-35 stand rejected under 35 U.S.C. § 101 as claiming non-statutory subject matter. Specifically, the Examiner asserts that these claims recite "a data association module" and "lack[] any physical hardware devices to actually perform the claimed intended utility." (21 May 2008 Office Action, Page 3).

Applicant respectfully directs the Examiner's attention to Claim 1, for example, which recites "a data association module coupled with one or more seller databases and a global content directory server." Applicant respectfully submits that the fact that the data association module is coupled to a global content directory server renders it as being coupled with a "physical hardware device" and thus, Applicant respectfully requests that the rejection to Claims 1-11 and 34-35 under 35 U.S.C. § 101 be withdrawn.

Claims 23-33 and 37 stand rejected under 35 U.S.C. § 101 as claiming non-statutory subject matter, specifically, "computer-readable medium."

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Disclosure may be express, implicit or inherent. Thus, at the outset, USPTO personnel must attempt to correlate claimed means to elements set forth in the written description. The written description includes the original specification and the drawings. USPTO personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See *Kemco Sales, Inc. v. Control Papers Company, Inc.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Further guidance in interpreting the scope of equivalents is provided in MPEP Sec. 2181 through Sec. 2186. While it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not impose that limitation. A broad interpretation of a claim by USPTO personnel will reduce the possibility that the claim, when issued, will be interpreted more broadly than is justified or intended. An applicant can always amend a claim during prosecution to better reflect the intended scope of the claim.

Whether a claim recites a machine implemented process is not determinative of whether that process claim is statutory. Such a test would recognize that an abstraction merely implemented on a computer is statutory. An example will illustrate the point. Assume that $y = 2x + C$, where x and C are positive real numbers, is nothing more than an abstract idea. The claim recites: a computer-implemented process comprising providing x and C defined as positive real numbers, multiplying x by 2 to get Z and determining y by adding C to Z . Thus, the claim is nothing more than an abstract idea which is machine implemented and such a claim is not statutory. See, e.g., *Benson*, 409 U.S. 63, 175 USPQ 673 (finding machine-implemented method of converting binary-coded decimal numbers into pure binary numbers unpatentable). However, using the machine implemented test, the claim would be found to be statutory.

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere

program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim. ** When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim. ** (MPEP § 2106.01(I)).

Although Applicant believes Claims 23-33 and 37 are directed to patentable subject matter without amendment, the Applicant has amended independent Claims 23 and 37 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

Accordingly, Applicant respectfully requests that the rejection to Claims 23-33 and 37 under 35 U.S.C. § 101 be withdrawn.

III. Rejection Under 35 U.S.C. § 102(b) Over Call

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over *Call*. In rejecting independent Claim 1 as anticipated by *Call*, the Examiner states that *Call* discloses the following:

[a] data association module operable to:

a) ***access a first product classification schema, the first schema comprising a taxonomy that comprising a hierarchy of classes for categorizing one or more products*** [e.g., col. 11, lines 61- col. 12, lines 46], ***the first schema further comprising ontology associated with one or more of the classes*** [e.g., the use of XML metadata & Document Type Descriptor techniques at col. 25, lines 26 - 34, 53-60], ***each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier*** [e.g.,

the use of universal product code cross-referencing schema with domain name services over an Internet at col. 21, lines 6 - col. 22, lines 53, Fig 6 and associated texts];

(21 May 2008 Office Action, Pages 5-6). (Emphasis added). Applicant respectfully disagrees with all of the above. Among other things, *Call* does not disclose the following limitations of independent Claim 1:

access[ing] a first product classification schema, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier;

Specifically, *Call* does not disclose at least “***access[ing] a first product classification schema, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes.***” The difference is clearly seen with reference to columns 11 and 12 of the specification of *Call* (provided below) on which the Examiner relies:

It is frequently desirable to transfer to another computer data created by the manufacturer which provides limited product description information for each product offered to enable more efficient indexing, cataloging, inventory control, and other applications. By way of example, in the bookselling industry, publishers, distributors, retailers, and libraries often require a ***database of bibliographic information which consists, for each book, of the book title, author name(s), publisher's name, publication date, type of book (hardcover, paperback, etc.), page count, recommended retail price(s), and ISBN number*** (which takes the form of a subpart of the EAN universal product code). To the extent the content and format of data records which describe particular classes of products in particular industries and trade groups have been previously adopted and placed in widespread use, those structured data records may advantageously be made available utilizing the present invention. This is preferably achieved in two ways: ***a data record (file) containing such field-structured information about each product*** which is designated by a universal product code is placed by the manufacturer in the directory it creates for that product. This ***structured data record is given a filename indicative of the format used to store the structured data***. For example, each directory bearing a name corresponding to the EAN number for a book would preferably contain a file named "biblio.dat" which

contains a *single structured record containing bibliographic data describing that book.*

In addition, *the manufacturer would place a combined file, also called "biblio.dat" in its root "/upcinfo" directory which contains all of the records for all of the products individually described in the subdirectories which have that structure in a single file.* For most manufacturers, these structured data files, both individual record files in the subdirectories and the combined file in the root directory, may be automatically created and updated on a periodic or dynamic basis from the content of the manufacturer's existing database. The use of a single combined file at each server permits multi-manufacturer databases to be created by first retrieving the IP-addresses of all or part of the crossreference table 215, and then retrieving and merging the combined data files from the "/upcinfo" directories from each identified server. Alternatively, *when information about all of a given manufacturer's products of a given type is not desired, the needed individual structured data files can be retrieved from the individual product directories.*

As described later in more detail, the information which the manufacturer makes available can advantageously be stored using *the eXtensible Markup Language (XML), which is also well suited for providing metadata which defines and describes the meaning of the various kinds of information* that can be provided about individual products, groups of products, and the manufacturers and distributors from which those products are obtained.

As seen above, *Call* describes a database containing records of bibliographic information for books and does not disclose “*a first product classification schema . . . comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products.*” Instead, *Call* merely describes, among other things, a collection of bibliographic information in database records. Applicant respectfully submits that the portion of *Call* on which the Examiner relies does not teach, suggest, or even hint at a “*product classification schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products,*” as recited by independent Claim 1.

The combined biblio.dat file described in *Call* is merely a combined file having multiple records, each of which contains bibliographic product information, and is not analogous to a “*product classification schema comprising a taxonomy comprising a hierarchy of classes for categorizing products,*” as recited by independent Claim 1. Rather, the biblio.dat file contains records of information that merely describes product characteristics but is not arranged in any manner that could be considered a “*taxonomy comprising a hierarchy of classes for*

categorizing products,” as recited by independent Claim 1. Applicant respectfully submits that bibliographic data contained in a database record, does not comprise a hierarchy of classes, but rather merely represents identifying information for a particular product. Accordingly, the portion of *Call* on which the Examiner relies does not teach, suggest, or even hint at “*access[ing] a first product classification schema, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes*,” wherein each of the one or more products is associated with a global unique identifier,” as recited by independent Claim 1.

Although further distinctions exist, the above is more than sufficient to show that *Call* clearly fails to anticipate independent Claim 1. Accordingly, Applicant respectfully traverses the rejection of Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102(b) and requests that the rejection of these claims be withdrawn.

IV. Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Call*

Applicant respectfully submits that the allegation in the Office Action that *Call* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Call* is considered to anticipate all of the limitations in independent Claims 1, 12, 23 and 35. *A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.* MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of Applicant’s claimed invention is identically shown in *Call*. For example, the Examiner appears to assert that the “*a first product classification schema . . . comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products*,” in independent Claim 1 is somehow equivalent to *a data record containing field-structured bibliographic information about each product* as described in columns 11 and 12 of the specification of *Call*. (21 May 2008 Office Action, Page 5). Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion.

Applicant respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Applicant respectfully submits that *the Office Action has failed to establish a prima facie case of anticipation in Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102 with respect to Call because Call fails to identically disclose each and every element of Applicant's claimed invention, arranged as they are in Applicant's claims.*

V. Applicant's Claims are Patentable over Call

Applicant respectfully submits that independent Claims 12, 23, 34, 36 and 37 are considered patentably distinguishable over *Call* for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33: dependent Claims 2-7 and 9-11 depend from independent Claim 1 and are considered patentably distinguishable over *Call*; dependent Claims 13-18 and 19-22 depend from independent Claim 12 and are considered patentably distinguishable over *Call*; dependent claims 24-29 and 31-33 depend from independent Claim 23 and are considered patentably distinguishable over *Call*. Thus, dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33 are considered to be in condition for allowance for at least the reason of depending from an allowable independent claim.

Thus, for at least the reasons set forth herein, Applicant respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are not anticipated by *Call*. Applicant further respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are in condition for allowance. Thus, Applicant respectfully request that the rejection of Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102(b) be reconsidered and that Claims 1-7, 9-18, 20-29, and 31-37 be allowed.

VI. Rejection Under 35 U.S.C. § 103(a) Over Call in view of Sahai

Dependent Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of *Sahai*. In particular, the Examiner states:

Call did not specifically disclose determining one or more classes of the first schema with which the at least a portion of the target data is associated comprising using statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema.

However, Sahai et al. (hereinafter referred as Sahai) discloses using statistical correlation techniques to identify portions of the target data including values as claimed [e.g., Title, Abstract, col. 3, lines 21- col. 4, lines 34, Fig(s) 4-9 and associated texts].

Call and Sahai are of the same field of endeavor to dynamically identify target data with a product classification schema via the use of a global unique identifier in the XML document, hence, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the statistical technique disclosed by Sahai into the system of Call, because by doing so, the combined system will be upgraded to use the well-known statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema, such that the combined system will provide a more precise response to the user in a decentralized manner.

(21 May 2008 Office Action, Page 8). However, neither *Call* nor *Sahai* whether taken together or separately disclose or suggest every element of independent Claim 1, 12, and 23, on which Claims 8, 19 and 30, respectively, depend. Independent Claim 1 provides, among other things:

access[ing] a first product classification schema, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier;

As discussed in detail above, *Call* does not teach these elements. *Sahai* does not provide the missing teachings. Therefore, the references do not alone or in combination, describe each element of independent Claims 1, 12, and 23, on which Claims 8, 19, and 30, respectively depend.

Accordingly, Applicant respectfully traverses the Examiner's obviousness rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) over *Call and Sahai*, either individually or in

combination and respectfully requests that the rejection to these claims under 35 U.S.C. § 103(a) be withdrawn.

VII. Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Call-Sahai* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Call or Sahai*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “***ensure that the written record includes findings of fact*** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “***factual findings made by Office personnel are the necessary underpinnings to establish obviousness.***” (*id.*). Further, “***Office personnel must provide an explanation to support an obviousness rejection*** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C.

132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject Application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Call and Sahai*, either individually or in combination. The Office Action merely states that “it would have been obvious . . . to *apply the statistical technique disclosed by Sahai into the system of Call.*” (21 May 2008 Office Action, Page 8). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Call and Sahai*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (*See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and *See* 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Call and Sahai, either individually or in combination, and Applicant's claimed invention, would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that "the combined system will be upgraded to use the well-known statistical correlation techniques to identify portions of the target data...such that the combined system will provide a more precise response to the user in a decentralized manner." (21 May 2008 Office Action, Page 8). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between the proposed combination of Call and Sahai, either individually or in combination, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that ***"the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit."*** (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that ***"[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."*** (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Call and Sahai to render obvious Applicant’s claimed invention*. The Examiner's unsupported conclusory statements that “it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the statistical technique disclosed by *Sahai* into the system of *Call*,” *does not adequately provide clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. (21 May 2008 Office Action, Page 8). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant’s claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Call* and *Sahai*, Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. § 103 as necessitated by the Guidelines, including an explicit analysis of the rationale relied upon by the Examiner.

VIII. *Call and Sahai, Individually and in Combination, Fail to Teach Various Limitations Recited in Applicant's Claims*

Applicant respectfully submits that dependent Claims 8, 19 and 30 are considered patentably distinguishable from *Call*. *Call*, as acknowledged by the Examiner, does not teach the unique and novel limitations taught in Claims 8, 19 and 30. This being the case, dependent Claims 8, 19 and 30 are considered patentably distinguishable over *Call*.

With further respect to dependent Claims 8, as mentioned above, dependent Claim 8 depends from independent claim 1, is considered patentably distinguishable over the *Call-Sahai* combination, and is considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 8, 19 and 30 are not obvious over *Call and Sahai*, alone or in combination. Applicant further respectfully submits that Claims 8, 19 and 30 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) be reconsidered and that Claims 18, 19 and 30 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

21 August 2008
Date

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